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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,498	11/19/2003	Eric Donsky	38055.00007.UTL1	8240

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BAKER & MCKENZIE LLP  
PATENT DEPARTMENT  
2001 ROSS AVENUE  
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DALLAS, TX 75201

EXAMINER
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CHRISTENSEN, RYAN S

ART UNIT	PAPER NUMBER
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2856

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/718,498

Applicant(s)

DONSKY, ERIC

Examiner

Ryan Christensen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-74 and 84-101 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-74, 84 and 85 is/are allowed.
- 6) ☒ Claim(s) 86-94 and 96 is/are rejected.
- 7) ☒ Claim(s) 95 and 97-101 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 86-88 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,951,894 (Nicolson et al.). With respect to claim 86 Nicolson et al. disclose a contact lens being removed from it's prior location and placed in a fluid (Col. 11, lines 14-28 or Col. 11, line 64 to Col. 12, line 4) and electrical properties of the fluid being measured (Col. 11, lines 28-35 or Col. 12 lines 4-15).

With respect to claim 87, the conductivity is correlated to an osmolarity measurement (variable dc, concentration difference, and the equation at Col. 11, line 35 demonstrate the osmolarity is determined through conductivity measurements in order find the unknown Ionoflux Diffusion Coefficient or variable C, concentration of sodium ions, in the equation at Col. 12, line 17).

With respect to claim 88, Nicolson et al. disclose a curve for converting electrical properties into sodium concentrations (Col. 12, lines 11-13). This curve inherently has a one to one correspondence between the measured electrical property and concentration.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 89-94, 96 Are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,965,631 (Nicolson et al.) in view of U.S. Patent 7,017,394 (Sullivan). With respect to claims 89 and 90, Nicolson et al. do not explicitly disclose that the step of storing osmolarity values on a memory device. Sullivan discloses a processor for determining osmolarity that contains memory for storing software and data (CPU, Col. 8, lines 29-31). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Nicolson et al. by including a memory device in order to quickly and accurately store measurement results and computational results.

With respect to claim 91, Nicolson et al. further disclose a placing a measurement chamber (donor chamber) in a base unit (lens retaining member, Col. 10 line 56 to Col. 11 line 28).

With respect to claim 92, Nicolson et al. disclose fluid in the measurement chamber (Col 11, lines 21-23).

With respect to claim 93, Nicolson et al. disclose the electrical properties of the fluid are known before being placed in he chamber meaning they are measured to establish a baseline (Col. 11, line 21-23).

With respect to claim 94, the baseline values are compared to the measured electrical properties after placing the lens in the fluid (Col. 11 lines 14-33).

With respect to claim 96, Nicolson et al. do not explicitly disclose displaying the measured osmolarity. However, Sullivan discloses displaying the osmolarity on an LCD or equivalent display device (Col. 3, line 48-51 and Fig. 7). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system taught by Nicolson et al. by including a display in order to provide instant feed back about a sample being tested.

#### ***Allowable Subject Matter***

Claims 1-74, 84 and 85 allowed.

Claims 95, 97-101 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Pertinent Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent Publication 2002/0196429 (Russell et al.) discloses a chamber for inspecting contact lenses.

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U.S. Patent 4,951,683 (Davis) discloses a device for measuring the conductance of tear film. The device contains a plurality of electrodes and suggests it can be in the form of a contact lens.

U.S. Patents 6,544,193; 6,423,001; and 6,120,460 (Abreu et al.) disclose a contact device for measuring parameters in a subject's eye and suggest osmolarity can be monitored.

U.S. Patent 4,123,701 (Josefsen et al.) discloses a chamber with electrodes for measuring samples of fluids.

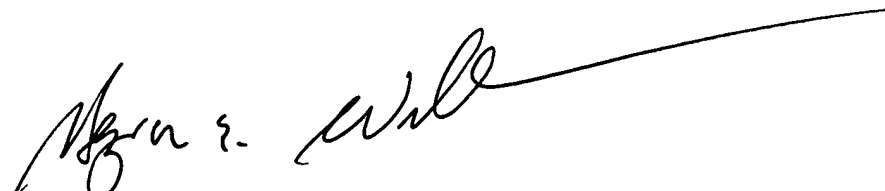
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Christensen whose telephone number is 571-272-2683. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams can be reached on 571-272-2208. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RSC



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